

REMARKS

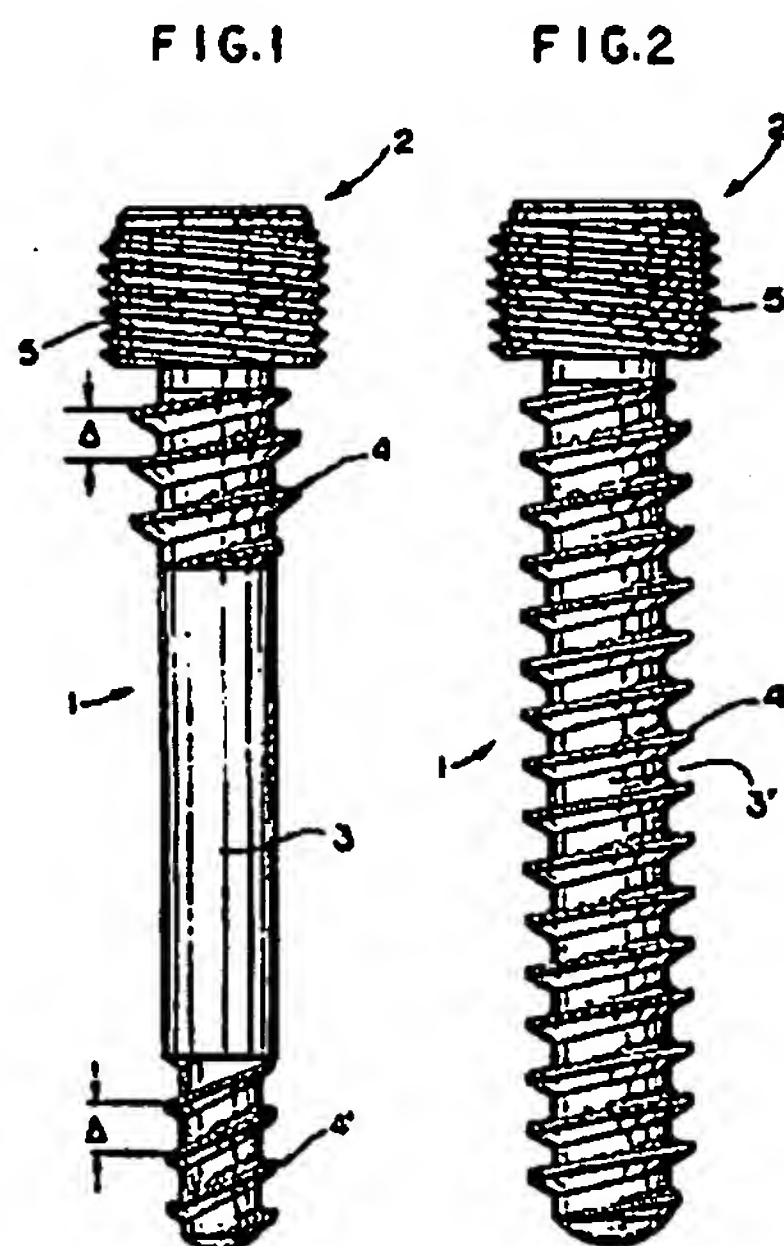
The above-identified application has been reviewed in light of the Office Action mailed on April 15, 2008. By the present amendment, the Applicants have amended claims 21, 35 and 40 and added claims 45-47. It is respectfully submitted that the claims pending in the application, namely claims 21, 23-28, 32-36, and 40-47, are fully supported by the specification, introduce no new matter, and are patentable over the cited references.

In the Office Action, claims 40, 43 and 44 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,536,127 to Pennig (hereinafter "Pennig"). The Office Action stated that Pennig discloses a surgical tack with a head having a drive thread, a barrel portion having a tissue engaging thread, wherein a portion of the drive thread and a portion of the tissue engaging thread define a gap therebetween, the distal end of the drive thread and the proximal end of the tissue engaging thread being in the same plane that extends through a longitudinal axis of the barrel portion.

Claim 40, as amended, recites a surgical tack for attaching a material to tissue including, *inter alia*, a head having a drive thread and a barrel portion having a tissue engaging thread, "the drive thread being one of a right-hand thread or left-hand thread" and "the tissue engaging thread having the same right-hand or left-hand thread as the drive thread."

As shown in FIG. 2, reproduced hereinbelow, Pennig discloses a screw 1 having a screw head 2 provided with a screw-head thread 5 and a shank 3 provided with a screw-shank thread 4. The thread-advance of screw-head thread 5 is directed opposite the direction of thread-advance of the screw-shank thread 4, i.e. one of these threads is a right-hand thread, and the other is a left-hand thread. The purpose for this configuration is illuminated as the specification continues, at column 2, line 62 through column 3, line 1.

This being the case, and as disclosed in said co-pending application, an internally threaded tool such as a nut may be threaded onto the head thread 5, to the point of engagement with a stop, such as an internal shoulder formation; once the stop is engaged, continued nut rotation in the same direction is operative to retract screw 1 from the patient's bone.



Thus, since Pennig specifically discloses a screw having a shank with the threads formed in one direction and the head with threads formed in the opposing direction, Pennig teaches away from a screw having two threads formed in the same direction. Therefore, Pennig fails to disclose or suggest a surgical tack including, *inter alia*, a head having a drive thread and a barrel portion having a tissue engaging thread, “the drive thread being one of a right-hand thread or left-hand thread” and “the tissue engaging thread having the same right-hand or left-hand thread as the drive thread”, as recited in amended claim 40. Accordingly, it is respectfully submitted that the rejection of the Office Action has been overcome and that claim 40 is in condition for allowance. Since claims 43 and 44 depend from amended claim 40, it is respectfully submitted that these claims are also in condition for allowance.

In the Office Action, claims 21, 23, 24, 27, 32-36, 41 and 42 were rejected under 35 U.S.C. § 103(a) as being obvious over Pennig in view of U.S. Patent No. 6,001,101 to Augagneur et al. (hereinafter "Augagneur"). According to the Office Action Pennig discloses a screw as described above, but fails to disclose a throughbore or threads being of the same pitch. The Examiner relies on Augagneur to teach the throughbore and threads of substantially the same pitch.

Claim 21, as amended, recites a surgical tack for attaching a material to tissue including, *inter alia*, a head having a drive thread and a barrel portion having a tissue engaging thread, "the drive thread being one of a right-hand thread or left-hand thread" and "the tissue engaging thread having the same right-hand or left-hand thread as the drive thread." Claim 35, as amended, recites a surgical tack including, *inter alia*, a head having a first thread and a barrel portion having a second thread, "the first and second threads being formed in the same right-hand or left hand direction."

As discussed above, Pennig does not disclose a screw having a first thread and a second thread that are formed in the same right-hand or left-hand direction. As also discussed above, Pennig teaches away from forming two threads on a screw in the same direction. Therefore, Pennig, taken in any proper combination with Augagneur, does not disclose or suggest a surgical tack having a first and second thread formed in the same right-hand or left-hand direction, as required by claims 21 and 35. Accordingly, it is respectfully submitted that the rejection of the Office Action has been overcome and that claims 21 and 35 are in condition for allowance. Since claims 23, 24, 27 and 32-34 depend from amended claim 21, and claims 36 and 41 depend from amended claim 35, it is respectfully submitted that these claims are also in condition for allowance.

Appl. No. 10/517,402
Amdt. Dated July 2, 2008
Reply to Office Action Mailed April 15, 2008

In the Office Action, claim 26 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Pennig and Augagneur, as applied to claim 21 above, and in view of U.S. Patent No. 6,030,162 to Huebner ("Huebner"). According to the Office Action, Pennig and Augagneur fail to disclose a chamfered drive thread on the head portion. The Office Action continues, noting that Huebner also fails to disclose a chamfered drive thread on the head portion, however, does disclose a chamfer on the leading section. The Office Action asserted that it would have been obvious to add a chamfered portion to the head portion.

As discussed hereinabove, Pennig and Augagneur fail to disclose or suggest the surgical tack recited in amended claim 21. Adding the chamfered portion disclosed in Huebner fails to cure the deficiencies of Pennig and Augagneur. Therefore, since claim 26 depends from independent claim 21, it is respectfully submitted that the rejection of the Office Action has been overcome and that claim 26 is in condition for allowance.

In the Office Action, claims 25 and 28 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Pennig and Augagneur, as applied to claim 21 above, in view of U.S. Patent No. 5,169,400 to Mühling et al. ("Mühling"). The Office Action stated that Augagneur discloses a throughbore, but fails to disclose that the throughbore has a D-shaped cross-section. According to the Office Action, it would have been obvious to modify the throughbore of Augagneur to include a shape that better applies the torque of an insertion tool as disclosed in Mühling.

As discussed hereinabove, Pennig and Augagneur fail to disclose or suggest the surgical tack recited in amended claim 21. Adding the non-circular throughbore of Mühling fails to cure the deficiencies of Augagneur. Mühling fails to disclose or suggest any features that, in combination with Augagneur, would suggest the surgical tack recited in amended claim 21.

Appl. No. 10/517,402
Amdt. Dated July 2, 2008
Reply to Office Action Mailed April 15, 2008

Since claims 25 and 28 depend from independent claim 21, it is respectfully submitted that these claims are in condition for allowance.

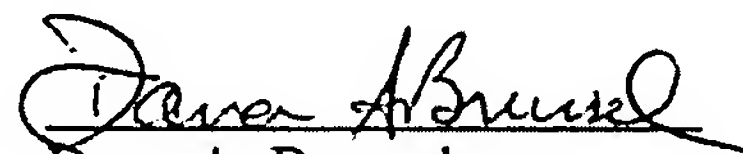
Applicant has added new claims 45-47. Since claim 45 depends from claim 21, claim 46 depends from claim 35, and claim 47 depends from claim 40, for at least the reasons claims 21, 35, and 40 are patentable, claims 45-47 are also believed to be patentable.

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 21-0550. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 21-0550 therefor.

Prompt and favorable action on these claims, namely claims 21, 23-28, 32-36, and 40-47, is earnestly requested. Should the Examiner desire a further telephonic interview to resolve any outstanding matters, the Examiner is sincerely invited to contact the undersigned at (631) 501-5713.

Respectfully submitted,

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road - Suite 225
Melville, New York 11747
Tel.: (631) 501-5713
Fax: (631) 501-3526


Dana A. Brussel
Reg. No. 45,717
Attorney for Applicants

Send correspondence to:
Chief Patent Counsel
Covidien
60 Middletown Avenue
North Haven, Connecticut 06473